

REMARKS

This paper is filed in response to the final official action dated October 19, 2005 (hereafter, "the official action"), and in furtherance to the Notice of Appeal received by the Patent Office on January 24, 2005. This paper is timely-filed, as it is accompanied by a petition for an extension of time to file in the first month and a check covering the requisite small entity extension fee of \$60.

Claims 1-20 are pending. By the foregoing amendments, claims 4, 8, and 15 have been amended, and claims 1-3, 7, and 12-14 have been canceled. Support for the amendments to claims 4, 8, and 15 may be found variously throughout the application and in the claims as originally filed. No new matter has been added.

Claims 4-6, 8-11, and 15-20 remain at issue.

In the official action, claims 1-7 and 12-20 were rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,825,253 to Speyer (hereafter, "Speyer") in view of U.S. Patent No. 6,193,635 to Webber *et al.* (hereafter, "Webber"), and in further view of U.S. Patent No. 4,971,305 to Rennex (hereafter, "Rennex"), U.S. Patent No. 4,444,396 to Wendt (hereafter "Wendt"), U.S. Patent No. 5,011,138 to Rankin (hereafter, "Rankin ") and the Choice1 Medical Distributors website advertisement "Hausmann Pulley Weights: Extra 2 lb Weight Plate" (hereafter, "Choice1"). Claims 8-11 were rejected under 35 U.S.C. §103(a) as obvious over Webber in view of Rennex, and in further view of Wendt, Rankin and Choice1.

The various bases for the claim rejections will be addressed in the order presented in the official action. Reconsideration of the application, as amended and in view of the following remarks, is solicited.

CLAIM REJECTIONS

The applicants respectfully traverse the rejections of claims 4-6 and 15-20 as obvious over Speyer in view of Webber, and in further view of Rennex, Wendt, Rankin, and Choice1. The applicants also respectfully traverse the rejections of claims 8-11 as obvious over Webber in view of Rennex, and in further view of Wendt, Rankin and Choice1.

A prima facie case of obviousness requires the satisfaction of three legal criteria. First, there must be some suggestion or motivation, either in the references

themselves, or in knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success in doing so. Third, prior art references, when combined, must teach or suggest all of the claim limitations. *See* M.P.E.P. §2142. These criteria have not been satisfied with respect to all pending claims 4-6, 8-11, and 15-20, as explained in more detail below.

Speyer discloses a weight training apparatus comprising a barbell and a set of free weights including a centrally disposed bore and a slot. Speyer does *not* disclose or suggest such a weight training apparatus in combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims 4-6, 8-11, and 15-20.

Thus, the examiner turned to Webber, Rennex, Wendt, Rankin, and Choice1. Based on these disclosures, the examiner asserted that it would have been obvious to modify "Speyer's weight plates into any of an array of sizes from 1/4 ounce to 45 pounds since the use of such a range of sizes is well known in the exercise art as shown by the representative references cited above and the practice of incrementally adding weight plates of various sizes during exercise is well known in the art." *See* official action at page 3. However, the cited references, whether taken alone or in any proper combination, fail to disclose or suggest a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus in combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims 4-6, 8-11, and 15-20.

Webber merely discloses a standard cable-type weight training apparatus and a set of plate/weights of standard increments such as 5 pounds, 10 pounds, etc. *See* Webber at column 6, lines 14-17. Webber also generally discloses add-on plates "in various incremental weights of 5 lbs or less." *See* Webber at column 6, lines 43-44. Webber therefore does not disclose or suggest a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus in

combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims.

Rennex discloses "a device which enables weight trainers to more conveniently select a particular weight and to make this weight selection with smaller weight increments than heretofore has been possible." *See* Rennex abstract. Rennex discloses increments with the smallest being 0.2 pounds (*i.e.*, 3.2 ounces). *See* Rennex at column 3, lines 10-12 and 40-43. Despite disclosing increments as small as 0.2 pounds, Rennex does not disclose any advantage that is specific to using such a small increment (which is still more than one and one-half times the *largest* increment of the present invention) in conventional weight training methods relative to a larger increment. Thus, Rennex does not disclose any motivation for using at least one incremental weight from a group of very small incremental weights including a one quarter-ounce weight, a one half-ounce weight, a one-ounce weight, and a two-ounce weight in combination with a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus.

Wendt discloses a weighted golf swing exercise club including a set of circular disks comprising one-ounce, two-ounce, four-ounce, eight-ounce, and sixteen-ounce weights. *See* Wendt at column 2, lines 36-40. Wendt does not disclose or suggest a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus in combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims.

For example, Wendt provides a single golf club shaft for use in conjunction with the series of weighted disks which is unrelated to weight training/bodybuilding. Thus, Wendt only discloses and contemplates *varying a single starting weight resistance* with the weighted disks in a dynamic "golf swing" motion. In contrast, the claimed invention relates to the use of at least one incremental weight in combination with a weight training apparatus such as a standard barbell and set of free weights or a

cable-type weight training apparatus such that *continuous incremental gains in weight training/bodybuilding* can be made without injury or failure because the starting resistances of the weight training apparatus used in combination therewith can be varied in very small increments to accommodate continued incremental increases in resistance.

Rankin discloses various games that use weighted discs weighing 1/8 ounce. Despite the patentee's characterization of such games as a sports device and as relating to manual weightlifting devices, such a characterization is inaccurate. For example, Rankin discusses how to play the various games and how scoring is accomplished. *See* Rankin at column 9, lines 19-34. Rankin does not disclose or suggest a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus in combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims.

Finally, Choice1 merely discloses a two pound plate for use with a standard cable-type weight training apparatus. Therefore, Choice1 does not disclose or suggest a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus in combination with at least one very small incremental weight from a group of incremental weights including a lightest weight which comprises a one quarter-ounce weight, and also including additional very light incremental weights which comprise a one half-ounce weight, a one-ounce weight, and a two-ounce weight, as recited by all claims.

Moreover, Speyer, Webber, and Choice1 illustrate the nonobviousness of the incremental weights in accordance with the invention because each of these documents provides a relatively large increment (the smallest being a two pound plate) as the lowest weight increment for weight training methods using a weight training apparatus. Such increments provide too large of an increase for adults, and such an increase in exercise resistance is proportionally larger for children. *See* present application at page 1, line 30 to page 2, line 2. Therefore, the applicant respectfully submits that further evidence of the non-obviousness of the claimed

subject matter is that Speyer, Webber, and Choice1 actually teach away from the claimed invention by teaching such a large weight increment.

For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner has not established that the cited documents themselves would have indicated to one of ordinary skill in the art that the various incremental weights disclosed by Rennex, Wendt, or Rankin in combination with Speyer's barbell and set of free weights or Webber's standard cable-type weight training apparatus would provide a benefit to a user by allowing the user to make *continuous incremental gains in weight training/bodybuilding* without injury or failure. Thus, the record indicates that the examiner combined the references using the appellants' disclosure as a template, which is improper. *See Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1784. Accordingly, the claim rejections should be reversed.

CONCLUSION

It is respectfully submitted that the application is now in condition for allowance. Should the examiner wish to discuss the foregoing amendments and/or comments, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney at the indicated telephone number.

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Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP



Patrick D. Ertel, Reg. No. 26,877

Attorney for Applicant

6300 Sears Tower

233 S. Wacker Drive

Chicago, Illinois 60606-6357

(312) 474-6300